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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/807,943	04/20/2001	Yan Hong	2977-123	9343

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WASHINGTON, DC 20005

EXAMINER

MAHATAN, CHANNING

ART UNIT	PAPER NUMBER
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1631

DATE MAILED: 05/26/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action**

Application No.

09/807,943

Applicant(s)

HONG ET AL.

Examiner

Channing S Mahatan

Art Unit

1631

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 29 April 2004 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

**PERIOD FOR REPLY** [check either a) or b)]

- a) ☒ The period for reply expires 6 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on \_\_\_\_\_. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ they raise the issue of new matter (see Note below);
- (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: \_\_\_\_\_

3. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.
4. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☐ The a) ☐ affidavit, b) ☐ exhibit, or c) ☐ request for reconsideration has been considered but does NOT place the application in condition for allowance because: \_\_\_\_\_.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: \_\_\_\_\_.

Claim(s) objected to: 8 and 15.Claim(s) rejected: 1-7, 9-14, 16, and 17.

Claim(s) withdrawn from consideration: \_\_\_\_\_.

8. ☒ The drawing correction filed on 10 December 2002 is a) ☒ approved or b) ☐ disapproved by the Examiner.

9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_

10. ☒ Other: See Continuation Sheet

C. Mahatan  
May 25, 2004

MARIANNE P. ALLEN  
PRIMARY EXAMINER

5/25/04

Art 1631

Continuation of 10. Other: Applicants' arguments, filed 29 April 2004, are found unpersuasive. With respect to the rejection of claim 17 under 35 U.S.C. 101 Applicants are directed to the office actions mailed 18 July 2003 and 29 January 2004; wherein the claim is to a data record viewed as non-functional descriptive material in the absence of executable code that would cause a computer to execute a specific process. Second, with respect to the rejection of claim 17 under 35 U.S.C. 112 1<sup>st</sup> Paragraph (New Matter) Applicants state "the functionality of the computer that is recited in claim 17 is disclosed and described in Fig. 1 of the application together with the corresponding written description as originally filed". However, the limitations broadly encompass any "conversion of said sequence of classified peak intensity symbols into a unique DNA fingerprint identifying a specific trait of said source of genomic DNA", whereas the only method indicated by the specification as being "acceptable" is the "Spring-and-Rubberband model" (Refer to below for further explanation). Finally, with respect to the rejection of claims 1-7, 9-14, 16, and 17 under 35 U.S.C. 112 1<sup>st</sup> (Scope of Enablement), particularly to Applicants' argument that "The Examiner...never explains what "other" means encompass by the claims", Applicants' are directed to the office action mailed 18 July 2003, which cites the specification as stating "a typical method of binning is to form ladder of the entire gel run, by lining up the gel lanes from the same run side-by-side so as to average out individual lane errors and to obtain a set of clear consensus rungs on the ladder into which the peaks are binned", however, the specification continues further to indicate that such an approach "exhibits an unacceptable deviation from the consistency and reproducibility requirements of the present invention, and thus a different method is used, according to the invention, which allows accurate and unbiased binning of peaks from a single lane, without the need to reference all other lanes in the run" (page 11, lines 1-13 of the Specification). As stated by specification there are "other means", and the instant claim broadly encompasses the "other means" (although such other means would be unacceptable). Again, the only disclosed means for obtaining DNA fingerprint profile data through alignment (i.e. acceptable) is the "Spring-and-Rubberband model" (pages 12-13). Therefore, the rejections under 35 U.S.C. 101 and 112 1<sup>st</sup> Paragraph are maintained for reasons of record.

It should be noted claims 8 and 15 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent from including all of the limitations of the base claim and any intervening claims.